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EXAMINER

THEIN, MARIA TERESA T

ART UNIT PAPER NUMBER

3627

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/865,470

Applicant(s)

ROSS, FREDERICK L.

Examiner

Marissa Thein

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Amendment

Applicant's "Response pursuant to 37 C.F.R. § 1.111" filed on November 5, 2004 has been considered with the following effect.

Applicant's response by virtue of amendment to claims 1-20 has overcome the Examiner's rejection of such claims under 35 USC 101.

Claims 1, 5-6, 11, 15-16 are amended. New claims 21-39 are added. Claims 1-39 remain pending in this application.

Response to Arguments

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Applicant remarks that "Junger does not disclose validating the return by matching the return validation code with a pre-authorization code provided by the consumer" as recited in claims 1 and 11.

The Examiner does not concur. Junger does disclose "the validating the return by matching the return validation code with a pre-authorization code provided by the consumer". In col. 7, lines 56-58, Junger discloses a customer reference number (e.g. bill of lading number, file number, invoice number, etc.) may be entered for an internal reference to identify the return authorization. In col. 8, lines 18-21, Junger discloses that if the request is approved a return authorization code is created to indicate approved status.

Such customer reference number (pre-authorization code) entered to identify the return authorization, and if approved provides a return authorization code (validation code) are considered the validation of the return by matching the return validation code with a pre-authorization code provided by the consumer.

Applicant remarks that "Junger does not disclose the crediting an account of the consumer for a return value of the returned item after validating the return" as recited in claims 1 and 11.

The Examiner directs Applicant's attention to the Office action below.

Applicant remarks that because of "reasons similar to those discussed above with regard to claim 1 Junger does not disclose, teach or suggest the element recited in claims 8-9 and 18-19".

The Examiner directs Applicant's attention to the Examiner's response to Applicant's previous remarks regarding claims 1 and 11.

Applicant remarks that "Claims 8-9 and 18-19 is improper at least because the Examiner has not shown a suggestion or motivation in the references or in the knowledge generally available to one of ordinary skill in the art to modify Junger"

In response to applicant's remark that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re*

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Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is that it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to providing a return validation code step prior to the receiving return request data step because such order of steps does not alter the purpose of the invention and because the subjective interpretation of the order does not patentably distinguish the claimed invention.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 21-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. The claimed invention must utilize technology in a non-trivial manner. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow

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apply, involve, use, or advance the technological arts. For example in claim 1, the method claim recites "a returns manager system" in the body of the claim. The body of the claim is a trivial use of the technology. Therefore, the claim is nothing more than an abstract idea, which is not tied to any technological art and is not a useful art. *Ex parte Bowman*, 61 USPQ2d 1665, 1671 (BD, Pats. App. & Inter. 2001). See MPEP 2106 IV 2(b).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 29, 31-35, and 37-39 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,085,172 to Junger.

Regarding claim 29, Junger discloses a system for managing a return of merchandise comprising; a retailer comprising at least one remote direct merchandiser from which one or more items may be purchased by a consumer (col. 3, lines 29-47; col. 2, lines 14-26); a returns manager system communicatively coupled to the retailer over a public communication network (col. 3, lines 29-55; Figure 3; col. 2, lines 14-26); receive a first communication identifying a return from a consumer, the return comprising at least a returned item of merchandise (col. 2, lines 41-49; col. 5, lines 5-

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35; Figures 4A-4B; col. 2, lines 14-26); identify the retailer as the remote direct merchandiser from which at least one returned item was purchased by the consumer (col. 3, lines 29-55; col. 2, lines 14-26); and send a second communication to the retailer identifying the return (col. 3, lines 29-55; col. 2, lines 14-26).

Regarding claims 31-35 and 37-39, Junger disclose the first communication is received from a local returns site communicatively coupled to the returns manager system (see at least col. 2, lines 41-46; col. 5, lines 5-35; Figures 4A-4B); the local returns site is operatively to receive the returned item from the consumer (col. 7, lines 56-58; Figure 4G); the local returns site is operable to receive from the returned item from a shipper (col. 4, lines 2-6); wherein the local returns is operable to process the returned item (col. 5, lines 5-8; col. 7, lines 18-31); receive a third communication from the local returns site, which comprises return validation data (col. 2, lines 46-52; col. 6, lines 30-36; col. 6, line 59- col. 7, line 6; col. 7, lines 54-59; col. 8, lines 18-21); transmit a fourth communication to the local returns site, which comprises return validation data having at least a return validation code (col. 2, lines 46-52; col. 6, lines 30-36; col. 6, line 59- col. 7, line 6; col. 7, lines 54-59; col. 8, lines 18-21); Internet (internet or the like); telephone network (Figure 3); and the first communication identifies an offer associated with the returned item (col. 2, lines 14-26).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-28, 30 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,085,172 to Junger in view of U.S. Patent Application Publication No. 2002/0128915 to Haseltine.

Regarding claim 1, Junger discloses a method of using a public communications network to manage the return of an item purchased by a consumer from a remote direct merchandiser, comprising the steps of:

- receiving a first communication at a return manager system (manufacturing side), the first communication comprising return request data from a local returns site (return side) (see at least col. 2, lines 41-46; col. 5, lines 5-35; Figures 4A-4B);
- providing a second communication from the returns manager system (manufacturing side) to the local return site (return side), the second communication comprising return validation data having at least a return validation code (return authorization number) (see at least col. 2, lines 46-52; col. 6, lines 30-36; col. 6, line 59- col. 7, line 6; col. 7, lines 54-59; col. 8, lines 18-21);
- validating the return by matching the return validation code (return authorization code, col. 8, lines 18-21) with a pre-authorization code (consumer reference number) provided by the consumer (col. 7, lines 56-59) and;

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- wherein the first and second communication using a public communication network (see at least col. 4, lines 39-54).

However, Junger does not explicitly disclose the crediting an account of consumer. Junger discloses the system provides the dollar value of the product that is authorized for return. The dollar value may be based on the lower of 1) gross invoice price paid by the Dealer for the product, less the value of allowances and incentives given to the Dealer, or 2) vendor's net product pricing at the time of the return. The dealer may deduct the monetary value of authorized returns from any existing or future vendor invoices. (See col. 8, lines 34-42). Furthermore in Figure 5A, the batch return authorization label provides a "return promptly for credit" information.

Haseltine, on the other hand, teaches the crediting an account of consumer for a return value of the returned item (paragraph 36).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Junger, to include the crediting of an account of the consumer, as taught by Haseltine, in order to provide instant credit or direct refund to the individual (consumer) (Haseltine paragraph 36).

Regarding claims 2-4 and 12-14, Junger discloses Internet; public network; and a combination of Internet access and public telephone access (see at least col. 4, lines 39-54).

Regarding claims 5-6 and 15-16, Junger discloses receiving a third communication at the returns manager system, the third communication comprising

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a request for general returns information from the consumer and providing a fourth communication from the returns manager system to the consumer, the consumer, the fourth communication comprising data representing general returns information to the consumer; and website (see at least col. 2, lines 44-58; col. 5, lines 9-15; col. 6, lines 11-20; col. 6, lines 30-46; col. 7, lines 51-62).

Regarding 7, 10, 17 and 20, Junger discloses accessing return policy data representing disposal of the item as desired by the direct merchandiser; and website (see at least col. 5, lines 9-15; col. 6, lines 58-64; col. 7, lines 7-17; col. 8, lines 42-44).

Regarding claim 11, Junger discloses a method of using a public communications network to manage the return of an item purchased by a consumer from a remote direct merchandiser, comprising the steps of:

- receiving a first communication at a return manager system (manufacturing side), the first communication comprising return request data from a local shipper (see at least col. 2, lines 56-60; col. 4, lines 7-19);
- providing a second communication from the returns manager system (manufacturing side) to the local return site (return side), the second communication comprising return validation data having at least a return validation code (return authorization number) (see at least col. 2, lines 46-52; col. 6, lines 30-36; col. 6, line 59- col. 7, line 6; col. 8, lines 18-21);
- validating the return by matching the return validation code (return authorization code, col. 8, lines 18-21) with a pre-authorization code

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(consumer reference number) provided by the consumer (col. 7, lines 56-59)

and;

- wherein the first and second communication using a public communication network (see at least col. 4, lines 39-54).

However, Junger does not explicitly disclose the crediting an account of consumer. Junger discloses the system provides the dollar value of the product that is authorized for return. The dollar value may be based on the lower of 1) gross invoice price paid by the Dealer for the product, less the value of allowances and incentives given to the Dealer, or 2) vendor's net product pricing at the time of the return. The dealer may deduct the monetary value of authorized returns from any existing or future vendor invoices. (See col. 8, lines 34-42). Furthermore in Figure 5A, the batch return authorization label provides a "return promptly for credit" information.

Haseltine, on the other hand, teaches the crediting an account of consumer for a return value of the returned item (paragraph 36).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Junger, to include the crediting of an account of the consumer, as taught by Haseltine, in order to provide instant credit or direct refund to the individual (consumer) (Haseltine paragraph 36).

Regarding claims 8-9 and 18-19, the combination Junger and Haseltine discloses providing a returns validation code to the consumer and the step of receiving return request data from the local returns site; and website. However, the combination does not disclose the step of providing a return validation code to the consumer is prior to the

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step of receiving return request data from the local returns site. The differences are only found in the order of the steps and do not alter the stated purpose of the invention. Thus, merely reciting an order of the steps of a method claim which accomplishes the same result is not sufficient to distinguish over the prior art. *In re Altiris Inc. v. Symantec Corp.*, 65 USPQ2d 1865 (CAFC 2003).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to providing a return validation code step prior to the receiving return request data step because such order of steps does not alter the purpose of the invention and because the subjective interpretation of the order does not patentably distinguish the claimed invention.

Regarding claim 21, Junger discloses a method for managing a return of an item, comprising a returned item purchased from an off-site retailer by a consumer (col. 3, lines 29-40; col. 3, lines 44-57); accessing a returns manager system (manufacture side) that stores a return policy of the off-site retailer, the return policy comprising one or more guidelines that must be met to validate a return of the returned item (vendors specific returns policy and guidelines, col. 8, lines 42-44; requirements of a company's return policy, col. 1, lines 29-30); and validating the return by determining that the return guidelines are met by the returned item (col. 1, lines 26-29; col. 8, lines 42-44).

However, Junger does not explicitly disclose the crediting an account of consumer. Junger discloses the system provides the dollar value of the product that is authorized for return. The dollar value may be based on the lower of 1) gross invoice price paid by the Dealer for the product, less the value of allowances and incentives

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given to the Dealer, or 2) vendor's net product pricing at the time of the return. The dealer may deduct the monetary value of authorized returns from any existing or future vendor invoices. (See col. 8, lines 34-42). Furthermore in Figure 5A, the batch return authorization label provides a "return promptly for credit" information.

Haseltine, on the other hand, teaches the crediting an account of consumer for a return value of the returned item (paragraph 36).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Junger, to include the crediting of an account of the consumer, as taught by Haseltine, in order to provide instant credit or direct refund to the individual (consumer) (Haseltine paragraph 36).

Regarding claims 22-28, Junger discloses receiving the returned item at a local returns site, the local returns site off-site from the retailer (col. 3, lines 44-55); providing pre-authorization of the return to the consumer before the item is received at the local returns site (col. 7, lines 56-58); transmitting a first communication comprising return request data to the returns manager system (manufacturing side) (see at least col. 2, lines 56-60; col. 4, lines 7-19); transmitting a second communication comprising return validation data from the returns manager system (manufacturing side), the return validation data comprising a return validation code (return authorization number) (see at least col. 8, lines 18-21); a pre-authorization code provided to the returns manager system by the consumer (col. 7, lines 56-58); accessing a rules-based disposition policy associated with the off-site retailer (col. 5, lines 15-39); selecting a disposition method for the returned product based on the rules-based disposition policy associated with the

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retailer (see at col. 5, lines 15-39; col. 8, lines 42-44; col. 1, lines 29-30); and sending a communication from the returns system to the retailer identifying the item being returned by the consumer (6, lines 30-41; col. 6, lines 64-67; col. 7, lines 11-17).

Regarding claims 30 and 36, Junger substantially disclose the claimed invention, however, it does not disclose update an account to reflect the status of the item as return pending and credit an account of the consumer. Junger discloses the system provides the dollar value of the product that is authorized for return. The dollar value may be based on the lower of 1) gross invoice price paid by the Dealer for the product, less the value of allowances and incentives given to the Dealer, or 2) vendor's net product pricing at the time of the return. The dealer may deduct the monetary value of authorized returns from any existing or future vendor invoices. (See col. 8, lines 34-42). Furthermore in Figure 5A, the batch return authorization label provides a "return promptly for credit" information.

Haseltine, on the other hand, teaches update an account to reflect the status of the item as return pending and credit an account of the consumer (paragraph 36).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Junger, to include the update an account to reflect the status of the item as return pending and credit an account of the consumer, as taught by Haseltine, in order to provide instant credit or direct refund to the individual (consumer) (Haseltine paragraph 36).

Conclusion

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 703-305-5246. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 703-308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mtot
February 7, 2005

A handwritten signature in cursive script that reads "Michael Cuff" followed by the date "2/7/05".

MICHAEL CUFF
PRIMARY EXAMINER